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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,677

Applicant(s)

TSAI ET AL. 

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Receipt of Remarks

1. Receipt is acknowledged of the response and remarks filed on August 7, 2003. Claims 1-
5 20 remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 15 3. Claims 1-6, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Maanen, Jr. (US 4,855,580).

Re claims 1 and 11, Van Maanen teaches a system 10 and method for inputting a first image data utilizing a first data input device such as image camera 12, and second image
20 capturing device 14 capturing and digitizing second image to be processed (see abstract, col. 1, lines 46+). The captured data is saved as a record, and are merged as needed/designed (col. 2, lines 6+).

Re claim 2, although Van Maanen discloses 16 as “remote receiving device”, and does not provide great detail, the device 16 stores captured data, and the document processing system

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10 resides on the device (col. 2, lines 37+). Accordingly, the device can be a PC or any computer equipped to perform these functions.

Re claims 3-6, 12-14, image pickup apparatus is one of image camera, OCR or MICR reader (col. 2, lines 24+), which processes documents to be scanned and digitized.

5

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20

6. Claims 7-10 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Maanen, Jr. (US 4,855,580) in view of Schmid et al. (US 5,659,164). The teachings of Van Maanen, Jr. have been discussed above.

25

Van Maanen, Jr. fails to specifically teach or fairly suggest that the image pickup apparatus is auto-feeding scanner, and image picking-up step invokes executing a text editor or e-mail editor.

Schmid teaches electronic image/document processing system wherein the stacked
5 documents are automatically fed to the scanner (col. 3, lines 26+; col. 3, lines 61+). The system further allows the scanned documents to be edited by e-mail editor to be distributed electronically or text editor for further process (col. 2, lines 57+). Schmid further teaches that the document can contain photographic material as recited in claim 17.

In view of Schmid's teaching, it would have been obvious to an ordinary skill in the art at
10 the time the invention was made to incorporate various features such as automatic feeder and invoking text/e-mail editor to the teachings of Van Maanen, Jr. in order to process a large volume of documents, and if needed, to edit and transmit the documents electronically. Implementing ADF (automatic document feeder) significantly improves throughput/volume of the document processing system, and save human intervention when processing multiple pages
15 of document. Moreover, by adding an automatic editor, the captured image/text can be customized, further streamlining editing process. These are well known features in document processing system, and one of ordinary skill in the art would be motivated to use for improving overall efficiency of the system, and therefore an obvious expedient.

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Response to Arguments

7. Applicant's arguments filed on August 7, 2003 have been carefully considered, but they are not persuasive.

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Applicant's remarks were carefully reviewed, however, it is the Examiner's view that the patent to Van Maanen, Jr. still discloses the invention disclosed in instant application.

Van Maanen, Jr. discloses a system for merging documents read from a plurality of sources and merging them into one document (see figure 1; col. 1, lines 5-9). The input devices
5 can be an image camera 12 and OCR/MICR reader 14. Although Van Maanen, Jr. does not explicitly suggest what remote reading device may be, the remote reading device should be capable of receiving document image from multiple sources, keeping track of and calculating time stamp values for the received image and being able to merge the documents, which meet certain conditions. A PC or some form of computer would be a reasonable embodiment of the
10 remote reading device 16.

Examiner also contends that "store" and "merge" function by the remote device is not patentably distinct from "open and save" by the data processing apparatus as Applicant argues. Although Van Maanen, Jr. does not provide step-by-step approach as Applicant did, the merge operation of Van Maanen, Jr. can be done in one of two approaches: first, use the first or second
15 file as a base file and append the other into the base file; second, open a new empty (temporary) file and merge the first and second files into the temporary file and save it. At least it is the Examiner's view that patentable support for one or the approach should be provided other than simply pointing out the difference between the two.

Applicant's remarks have been given careful consideration, however, for the reasons
20 stated above, it is the Examiner's opinion that the Van Maanen, Jr. patent still teaches the subject matter disclosed in the instant application. This Office Action, therefore, is made final.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

5 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, 10 however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: McMillin (US 5,103,490); Romano et al. (US 5,920,685) disclose a document merging system.

15 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's 20 supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and 30 Trademark on February 25, 1997 at 1195 OG 89.*

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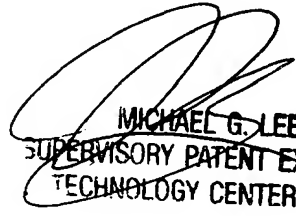
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim
Patent Examiner
Art Unit 2876
January 5, 2004

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MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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